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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,362	10/31/2000	Shinichiro Hirota	024705-107	8653

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EXAMINER

COLAIANNI, MICHAEL

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 12/12/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/699,362

Applicant(s)
Hirota et al.

Examiner
Michael Colaanni

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1731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 27, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Oct 31, 2000 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Election/Restriction

1. Applicant's election with traverse of Group I, claims 1-18 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the two groups of inventions are sufficiently related to merit examination in a single application. Applicant alleges that a search for the method of assembling the apparatus would turn up relevant art related to the method of pressing the glass. This is not found persuasive because as noted in the restriction requirement, the claims in Group II do not require the same limitations as those of Group I. Thus, a search of the prior art for Group II, would not be coextensive with that of Group I. The additional searching would be burdensome on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 19-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Drawings

3. Figures 9 and 10 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lower mold having the forced mold separating means as claimed in claims 9-15 and method claim 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by
McNamara 1909374.

McNamara teaches applicant's claimed invention comprising a device and method for manufacturing molded glass articles by press molding a heated glass gob between an upper and lower mold, the device having a drum capable of regulating said upper mold and lower mold so that the displacement axes thereof align (Fig. 1, ref. no. 6); a forced mold separating means

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separating said molded glass article adhered to a forming surface from the mold by contact with at least the rim portion of said molded glass object (Fig. 1, ref. no. 31); and a displacement means for displacing said forced mold separating means relative to the upper mold so that in the course of separation of the upper mold and the lower mold, the forced mold separating means contacts at least the rim portion of the molded glass article and separates the molded glass article from the forming surface (Fig. 1, ref. no. 18).

McNamara also teaches the upper mold is separated from the glass article by contacting at least a portion of the rim of said molded glass article (Fig. 12 and 31).

McNamara also teaches that the lower mold pushes the force mold separating means upward (Fig. 1, ref. no. 10, 6, 11, 31).

McNamara also teaches claim 4 (Fig. 1, ref. no. 12, 31).

McNamara teaches using energizing means to effect the displacement of the upper and lower molds (Fig. 1, ref. no. 18, 12, 10).

McNamara also teaches claims 7 and 8 (Fig. 1, ref. no. 12, 31, 7 and 6).

As to the method claim, McNamara teaches the method as noted above with regard to the apparatus limitations.

7. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirota et al. JP 11-49523.

Hirota et al. teach applicant's claimed invention comprising a device and method for manufacturing molded glass articles by press molding a heated glass gob between an upper and

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lower mold, the device having a drum capable of regulating said upper mold and lower mold so that the displacement axes thereof align (Fig. 7, ref. no. 350); a forced mold separating means separating said molded glass article adhered to a forming surface from the mold by contact with at least the rim portion of said molded glass object (Fig. 7, ref. no. 324, 350); and a displacement means for displacing said forced mold separating means relative to the upper mold so that in the course of separation of the upper mold and the lower mold, the forced mold separating means contacts at least the rim portion of the molded glass article and separates the molded glass article from the forming surface (Fig. 7, ref. no. 25 and 352).

Hirota also teaches the upper mold is separated from the glass article by contacting at least a portion of the rim of said molded glass article (Fig. 4 ref. no. 124).

Hirota also teaches that the lower mold pushes the force mold separating means upward (Fig. 4, ref. no. 30, 124).

Hirota also teaches claim 4 (Fig. 1, ref. no. 24, 30).

Hirota teaches using energizing means to effect the displacement of the upper and lower molds (Fig. 1, ref. no. 25, 20, 30).

Hirota also teaches claims 7 and 8 (Fig. 1, ref. no. 24, 20, 30).

Hirota also teaches claims 9-15 with respect to the lower mold (Fig. 7, ref. no. 352, 354, 330).

As to the method claim, Hirota teaches the method as noted above with regard to the apparatus limitations.

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Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 9-15, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNamara 1909374 in view of Hirota et al. JP 11-49523.

McNamara teaches applicant's claimed invention. See the §102(b) rejection above for McNamara's teaching. However, McNamara does not teach the forced mold separating means interrelationship with the lower mold as claimed in claims 9-15 and 17; also McNamara does not teach controlling the movement of the upper mold to compensate for thermal contraction of the glass.

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However, merely reversing the forced mold separating means placement and putting it on the lower mold is deemed obvious. Given McNamara's teachings, one of ordinary skill in the art would readily appreciate that the separation could equally be achieved by placing it on the lower mold instead of the upper mold. There are no unexpected results from having placed the forced mold separating means on the lower mold. Clearly, one viewing McNamara's teaching would appreciate that the lower mold could be equipped with the mold separating means. Moreover, Hirota et al. teach using a lower mold separating means (Fig. 7, ref. no. 352, 350). Thus, one viewing McNamara in view of Hirota et al. would recognize that McNamara's teachings could be equally applied to the lower mold. Finally, adjusting the upper mold to compensate for the thermal contraction of the glass would have been obvious because doing so would produce a more accurately pressed glass part.

It would have been prima facie obvious at the time the invention was made to combine Hirota's teachings with McNamara's device and method for molding glass for the reasons given in the body of the rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Colaianni whose telephone number is 703-305-5493. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin, can be reached on (703) 308-1164. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



MICHAEL COLAIANNI
PRIMARY EXAMINER

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December 10, 2002